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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/509,853 | 06/08/2000 | RAYMOND DE CAGNY | RSA254AUS | 1690 |

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| EXAMINER |
|---|
| STORMER, RUSSELL D |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3617 | |

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 09/509,853 | R. De Cagny |
| **Examiner** | **Art Unit** |
| Russell D. Stormer | 3617 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *30 Apr 2002*.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-26* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☒ The proposed drawing correction filed on *28 Jun 2001* is: a) ☒ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. Upon filing of the Appeal Brief, it was determined that claim 5 had not been treated on the merits in the final rejection due to a typographical error.

Further, upon the filling of the Appeal Brief, the amendment after final filed January 24, 2002 has been entered.

Accordingly, the final rejection is withdrawn and a supplemental, non-final action follows.

***Specification***

2. The substitute specification filed June 28, 2001 is approved and entered.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5, 7, 8, 9, 10, 11, 12, 14, 17, 20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Woolson.

Woolson discloses a tire balancing weight comprising a weight 10 embedded or encased in a member 8 which is mounted to the tire. The member 8 is called a patch by Woolson, but is considered to be a case as broadly recited in the claims, and the member is vulcanized to the tire.

To be vulcanized to the tire the case must be melted to some degree, and therefore the side of the case which is directly joined to the tire would comprise the means for mounting the case to the tire sidewall. Or, the surface of the case itself could be the means for mounting as this surface which contacts the tire holds the case to the tire. Though formed of linked members, the weight 10 is considered to be a single weight because the links, as joined together and enclosed in the case, make up a single balancing weight to be applied to the tire..

With respect to claim 5, the rubber material of the case of Woolson is a plastic material.

5. Claims 20 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Thissen et al (EPO 222391; newly cited).

The balancing weight 1 is encased in rings 30, 70 which form a case around the weight. The balancing device is mounted firmly to a surface of a side 28 of the tire as it is wedged in place.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 3, 4, 6, 18, 19, 21, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson.

Woolson meets all of the limitations of claim 1 as set forth in paragraph 6 above but the material of the weight is not specifically set forth as being iron alloy or zinc and aluminum alloy. However, at lines 62-64 of page 1, Woolson describes the weights or links 10 as being made of any suitable material. Such suitable materials would include iron alloy (steel) and aluminum and zinc alloys since those of ordinary skill in the art would readily know that sch material would perform well as balancing materials and would further be resistant to weather and would also be less poisonous than lead.

With respect to claim 6, the device would inherently include a convex surface during flexing of the tire.

With respect to claims 18 and 19 the color of the case is not patentable.

With respect to claim 21, to mount at least one device on each side of the tire would have been obvious to those of ordinary skill in the art in as needed to balance the tire.

With respect to claims 24 and 25, Woolson states that the balancing weight is vulcanized to "one side of the tire." Although not specified, it would have been obvious to mount the weight on the outboard surface of the tire to allow inspection, or on the inboard surface in order to hide the device. The device would balance the tire just the same, and those of ordinary skill in the art could readily determine which side of the tire the weight should be mounted to.

8. Claims 13, 15, 16, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson in view of Turoczi Jr...

To use an adhesive or glue to mount the device to the tire would have been obvious as taught by Turoczi Jr... as such is well-known and would be a simpler and less expensive alternative to the vulcanization used by Woolson.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson in view of Flebbe (German 3632981; newly cited).

For the tire to include a circumferential groove for the reception of the balancing device would have been obvious as taught by Flebbe. Note the grooves in the tire, the spacer, and between the two as shown in figure 1 of Flebbe.

***Response to Arguments***

10. Applicant's arguments filed June 28, 2001, and the arguments filed January 24, 2002 have been fully considered but they are not persuasive.

Because the balancing weight of Woolson is encased in the patch-like member 8, the weight is enclosed in a case. The articulated links 10 comprise a single weight when assembled together. The single weight made up of a plurality of links is then encased in the patch or case. Note lines 75-85 which state that other forms of weight may be used.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-3768.

rds

July 12, 2002

RUSSELL D. STORMER
PRIMARY EXAMINER
7/12/02